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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,913	11/30/2006	Nicolas Bara	BDM-06-1202	1435

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IP GROUP OF DLA PIPER LLP (US)  
ONE LIBERTY PLACE  
1650 MARKET ST, SUITE 4900  
PHILADELPHIA, PA 19103

EXAMINER
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WRIGHT, MADISON L

ART UNIT	PAPER NUMBER
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3781

NOTIFICATION DATE	DELIVERY MODE
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01/29/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pto.phil@dlapiper.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/585,913	<b>Applicant(s)</b> BARA, NICOLAS	
	<b>Examiner</b> Madison L. Wright	<b>Art Unit</b> 3781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-31 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 10. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 28-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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had possession of the claimed invention. The applicant does not distinguish which housing is being described in claim 18. Is it the lower part housing as shown in the drawings? Is "the housing" also the "sleeve"? In claims 29 and 30, the engraving is on the sleeve and not on the tube, therefore when the tube is inserted into the sleeve then the identification would not be masked.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 19, 20, 24, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 19 recites the limitation "the connecting means" in the first two lines of claim 19. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 20 recites the limitation "the connecting means" in the last line of claim 20. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 24 recites the limitation "the elevated engraving" in the last line of claim 24. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 28 recites the limitation "the contents" in the last line of claim 28. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 17-26 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,763,395 to Meek ("Meek") in view of U.S. Patent No. 4,724,972 to Marcus ("Marcus").

As to claim 33, Meek teaches a unit that receives biological specimens comprising: a sleeve (receptacle part 11); a tube (diffuser unit 10) shaped and sized to slide into the sleeve (Fig. 1) and provided with a system (col. 2, lines 63-71 and col. 3, lines 1-2) that interlocks the sleeve on the tube in a single direction at first and second levels (Fig. 2); and a plug (cover 12) having an opening (Fig. 1), wherein after interlocking at the first level (Fig. 1), the sleeve is integrated to the tube in a single direction and after interlocking at the second level (Fig. 2), but does not teach a tube shaped and sized to contain biological specimens and the opening of the plug brings about a physical transformation of the sleeve and not of the plug, the physical transformation being irreversible and visible.

Marcus teaches a container 10 that has a body 12 and a cap 14 with a sidewall 16, the cap having a separately produced lid member 30 affixed therein, the cap and lid member combining to form a closure 58. A flag 50 is detachable affixed in a break-away manner to the container wall 12 and cap 14.

Meek modified by Marcus does not disclose a tube shaped and sized to contain biological specimens. However, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed

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does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations *Ex parte Masham 2* USPQ2d 1647 1987).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the flag of Marcus with the unit as taught by Meek to have the flag act as a reminder to consumers to check for tampering (Marcus, col. 2, lines 37-38).

As to claim 17, Meek modified by Marcus teaches the apparatus according to claim 33, wherein the plug and tube can be interlocked (Fig. 1).

As to claim 18, Meek modified by Marcus teaches the apparatus according to claim 33, further comprising a connecting means integral with the sleeve, as taught by Marcus. Marcus teaches a flag 50 is detachable affixed in a break-away manner to the container wall 12 and cap 14.

As to claim 19, Meek modified by Marcus teaches the apparatus according to claim 33, wherein the connecting means is a divisible clamp, as taught by Marcus. Marcus teaches a flag 50 is detachable affixed in a break-away manner to the container wall 12 and cap 14.

As to claim 20, Meek modified by Marcus teaches the apparatus according to claim 33, wherein the physical transformation is a rupture or tear of the connecting means, as taught by Marcus. Marcus teaches a flag 50 is detachable affixed in a break-away manner to the container wall 12 and cap 14 (Marcus, col. 2, lines 34-37).

As to claim 21, Meek modified by Marcus teaches the apparatus according to claim 33, wherein interlocking of the sleeve is made by irreversibly sliding the tube into the sleeve (Meek, col. 2, lines 63-71 and col. 3, lines 1-2).

As to claim 22, Meek modified by Marcus teaches the apparatus according to claim 33, wherein the sleeve and the tube are made of different materials (Fig. 3).

As to claim 23, Meek modified by Marcus teaches the apparatus according to claim 33, wherein the sleeve is composed of a material that allows engraving an indelible and unitary identification. Since the container, as taught by Meek, is made of plastic (Meek, col. 2, lines 41-42) then it can be engraved using a knife.

As to claim 24, Meek modified by Marcus teaches the apparatus according to claim 23, wherein the sleeve is composed of a material that allows reading of the elevated engraving. As best understood, the engraving that was done with a knife could be elevated engraving.

As to claim 25, Meek modified by Marcus teaches the apparatus according to claim 18, wherein the connecting means is a tongue that can be integrated in a definitive and non-replaceable manner with the sleeve and the plug, as taught by Marcus. Marcus teaches a flag 50 is detachable affixed in a break-away manner to the container wall 12 and cap 14 (Marcus, col. 2, lines 30-38).

As to claim 26, Meek modified by Marcus teaches the apparatus according to claim 25, wherein integration of the tongue is carried out with an adhesive band that can not be violated by tearing. In as much as shown by applicant, the apparatus as taught by Meek modified by Marcus is capable of performing the function.

12. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meek in view of Marcus further in view of U.S. Patent No. 4,640,427 to Marino et al. ("Marino").

As to claim 27, Meek modified by Marcus teaches the apparatus according to claim 25, but does not teach wherein integration of the tongue is carried out by welding.

Marino teaches a container 10 with a closure 11 having a depending tab 12 that is fused or partially melted at 15 to form a permanent bond between the inner surface of the depending tab and the outer surface of the container.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the partially melted area of Marino with the apparatus as taught by Meek modified by Marcus to have an indication that the container has been opened (Marino, col. 1, lines 45-52).

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 17-33 have been considered but are moot in view of the new ground(s) of rejection.



***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments

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made to the disclosure. See MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madison L. Wright whose telephone number is 571-270-7427. The examiner can normally be reached on Monday thru Friday, 8:00 to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony Stashick/  
Supervisory Patent Examiner, Art  
Unit 3781

/M. L. W./  
Examiner, Art Unit 3781